

RESPONSE UNDER 37 C.F.R. § 1.116  
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### **REMARKS**

Upon entry of this amendment, claims 1-8 and 10-30 are all the claims pending in this application. Claim 9 is canceled by this amendment.

#### **I. Information Disclosure Statement**

In Applicant's previous response, a clean copy of the December 20, 2001 PTO form 1449 was submitted, listing only the reference which the Examiner had failed to initial. In the present Office Action, the Examiner states that the Information Disclosure Statement has been considered and that the initialed PTO form 1449 is enclosed. See Office Action at page 2.

Applicant thanks the Examiner for considering all of the references. Applicant notes, however, that the initialed PTO form 1449 was not enclosed with the Office Action mailed April 2, 2003. Therefore, Applicant kindly requests that the Examiner re-submit the initialed PTO form 1449 with the next Office paper.

#### **II. Request to Withdraw Finality of the Office Action**

In the present Office Action, the Examiner asserts that the same grounds of rejection have been maintained and, therefore, the Examiner has issued a final rejection. Applicant respectfully disagrees with the Examiner's position.

In the non-final Office Action, the Examiner asserted that Lang teaches the feature of an operator which must be certified before being allowed to input update data. Applicant

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respectfully disagreed and explained to the Examiner that Lang fails to teach such a feature.

Further, Applicant asserted that Bosen failed to cure this deficiency of Lang.

The Examiner apparently agreed with Applicant because in the present Office Action, rather than asserting that Lang discloses the feature of an operator which must be certified before being allowed to input update data, the Examiner states that:

“[I]t would have been obvious to one of ordinary skill in the art that if a user must be certified to gain access to sensitive information contained on secured data storage devices, then an equivalent or greater certification must be in place before an operator may input new or updated data onto the storage device.”  
See Office Action at page 3.

Therefore, contrary to the assertion of the Examiner, the same grounds of rejection have not been maintained. Rather, the Examiner has changed the grounds of rejection by initially asserting in the non-final Office Action that Lang discloses a claimed feature and, subsequently, in the present Office Action, asserting that it would have been obvious to provide the same claimed feature. In effect, the Examiner is rejecting the claims over Lang, Bosen and “Official Notice.”

Based on the foregoing, it is clear that the grounds of rejection have, in fact, changed. Applicant respectfully submits that the current grounds of rejection should have been made of record by the Examiner in the first Office Action. By making the present Office Action a final action, Applicant has not been afforded the opportunity to respond by amending the claims as a matter of right.

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Indeed, the Federal Circuit has stated that “where the board makes a decision advancing a position or rationale new to the proceedings, an applicant must be afforded an opportunity to respond to that position or rationale by submission of contradicting evidence.” *In re De Baluwe*, 736 F.2d (1984).

By initially asserting that Lang disclosed a claimed feature and, subsequently, stating that the same claimed feature would have been obvious to one of ordinary skill in the art, the Examiner has clearly advanced a new position and rationale. Therefore, Applicant respectfully submits that the Examiner has presented a new grounds of rejection that was not necessitated by an amendment made by Applicant and, therefore, that the finality of the present Office Action should be withdrawn.

### **III. Claim Rejections under 35 U.S.C. § 103(a)**

Claims 1-30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lang (U.S. Patent No. 5,191,611) in view of Bosen et al. (U.S. Patent No. 4,907,268). Applicant respectfully traverses this rejection on the following basis.

Claim 1 has been amended to include features recited within dependent claim 9 and, accordingly, claim 9 has been canceled. Claim 1, as amended, recites the features of a physical characteristic data obtaining unit, a third storage unit which stores a physical characteristic data file which pre-stores data on physical characteristics of a certified operator, and a controller which determines whether an operator is certified based on a comparison between the data obtained by the physical characteristic data obtaining unit and the data stored in the third storage

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unit. Applicant submits that the claimed combination, including at least these features, is neither taught nor suggested by the cited prior art.

Regarding these claimed features, the Examiner makes a broad statement that Lang discloses the use of biometric information (See Office Action at page 12). While Lang may disclose the use of biometric information, Applicant respectfully submits that the mere disclosure of biometric information clearly does not correspond to the specific features recited in amended claim 1.

That is, Lang does not teach or even remotely suggest a third storage unit which stores a physical characteristic data file which pre-stores data on physical characteristics of a certified operator and a controller which determines whether an operator is certified based on a comparison between data obtained by a physical characteristic data obtaining unit and data stored in the third storage unit, as is required by claim 1.

Therefore, as the combination of Lang and Bosen fails to teach or suggest all of the features of claim 1, Applicant respectfully submits that a prima facie case of obviousness has not been established and kindly requests the Examiner to reconsider and withdraw the rejection. If the Examiner persists in this rejection, Applicant respectfully requests the Examiner to particularly point out the structure and passages in the cited prior art that are being relied upon for teaching the above discussed features so that Applicant may make an informed decision with regard to an appeal.

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Applicant submits that independent claim 16, as amended, is patentable for similar reasons as discussed above regarding independent claim 1. Namely, the combination of Lang and Bosen fails to teach or suggest the features of a physical characteristic data storage means for pre-storing data relating to physical characteristics of a certified operator, a physical characteristic data obtaining means for obtaining data relating to physical characteristics of an operator, and user verification means for determining whether an operator is certified based on comparison between the data relating to the physical characteristics of the operator obtained by the physical characteristic data obtaining means and the data relating to the physical characteristics stored in the physical characteristic data storage means.

Applicant submits that independent claims 19, 27 and 29, as amended, are patentable for similar reasons as discussed above regarding independent claim 1. Namely, the combination of Lang and Bosen fails to teach or suggest the feature of discriminating whether a certified operator operates the system or not by obtaining data relating to physical characteristics of an operator and comparing the obtained data with pre-stored data relating to physical characteristics of the certified operator.

Regarding dependent claims 2-8, 10-15, 17, 18, 20-26, 28 and 30, Applicant submits that these claims are patentable at least by virtue of their dependency on their respective base claims for the reasons discussed above.

In addition, dependent claim 10 recites the feature of a first recording medium which further stores data relating to the physical characteristics of the certified operator. The Examiner, however, has not addressed this particular feature of the claimed invention. Rather, the

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Examiner simply makes a broad statement that Lang discloses the use of biometric information (See Office Action at page 12). While Lang may disclose the use of biometric information, Applicant respectfully submits that such disclosure clearly does not correspond to the specific features recited in claim 10.

As disclosed in Lang, biometric information pertaining to a user may be stored on a storage unit (e.g., a CD ROM), wherein data in the storage unit is stored in logical zones (column 2, lines 54-58). When a user attempts to access the storage unit, a determination is made as to which logical zones the user is permitted to access (column 2, lines 60-67). Based upon this determination, each user is assigned a particular zone access code (ZAC) which is translated into corresponding logical zones using an index table stored in the storage unit (column 3, lines 2-6).

The index table includes the ZAC, a system identification code, a personal security key code, plus the possible use of biometric coded information, as well as the logical zones assigned to the ZAC for each user (column 3, lines 13-17). The index table is included in the storage unit (e.g., CD ROM) when the storage unit is manufactured (column 3, lines 18-19).

Based on the foregoing, it is clear that any and all biometric information pertaining to a user is stored solely on the storage unit (e.g., CD ROM). Lang clearly does not teach or suggest that biometric information may be stored on the storage unit as well as on the first recording medium (i.e., the smart card as disclosed by Lang), as is required by claim 10. Furthermore, Bosen fails to cure this deficiency of Lang.

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Therefore, as the combination of Lang and Bosen fails to teach or suggest all of the features of claim 10, Applicant respectfully requests that the Examiner reconsider and withdraw the rejection. If the Examiner persists in this rejection, Applicant respectfully requests the Examiner to particularly point out the passages in the cited prior art which teach the above discussed features.

**IV. Conclusion**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

  
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